

Appl. No. 10/672,645  
Amdt. dated Aug 23, 2005  
Reply to Office action Dated June 21, 2005

### **REMARKS/ARGUMENTS**

Figure 4 was previously modified to include a secondary rotating member 150 connected to the first rotating member with a bearing 142. Changes were made to claims 6 and 13 to include attachment to only the second member, and to exclude describing the third member as a cover.

Claim 1 was modified as shown below.

Claim 1 (currently amended): A wheel cover for a vehicle comprising;

~~a first~~ an inner member with attachment mechanism for connecting the ~~first inner~~ member to a vehicle rim,

~~a second~~ at least one outer member that is not eccentrically weighted, and located on the outer side of the inner member away from the vehicle rim wherein the entire outer facing surface of the outer member that is not secured to the vehicle rim is visible.

a bearing mechanism that connects the ~~first inner~~ member to the ~~second outer~~ member to allow the members to turn independently from each other, ~~and wherein the second member is located outside the first member away from the vehicle rim.~~

These changes identify that the outer member as located on the outer side of the inner member away from the vehicle rim. These changes are supported in the specifications, figures and the fact that the outer member, by virtue of being outside the member that attaches to the vehicle rim, must be visible.

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Claim 8 was modified as shown below.

Claim 8 (currently amended) A wheel cover for a vehicle comprising;  
a first member with attachment mechanism for connecting the first member to a vehicle rim,  
  
a bearing mechanism connected to at least a part of the first member and the bearing mechanism is connected to at least a part of a second member where;  
  
the second member is located outside the first member away from the vehicle rim and the entire outer facing surface of the outer member that is not secured to the vehicle rim is visible.  
  
the second member can spin or turn independent from the first member, and,  
  
at least a portion of the rotational inertia from the first member turning is transferred to the second member.

These changes identify that the second member as being located outside the first member, away from the vehicle rim. These changes are supported in the specifications, figures and the fact that the outer member, by virtue of it location away from the vehicle rim, must be visible.

Claims 4 and 11 were modified as shown below.

Claim 4 (currently amended) The wheel cover as recited in claim 1 wherein the outer member is made from a group of materials consisting of metal, plastic, and or rubber.

Claim 11 (previously presented) The wheel cover as recited in claim 8 wherein the outer member is made from a group of materials consisting of metal, plastic, and or rubber.

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The change to claims 4 and 11 change the word "and" to the word "or" in regards to the member is made from.

Claims 5 and 12 were modified as shown below.

Claim 5 (currently amended) The wheel cover as recited in claim 1 wherein the bearings are made from a group of materials consisting of ball bearings, plastic bearings, and bronze bearings

Claim 12 (currently amended) The wheel cover as recited in claim 8 wherein the bearings are made from a group consisting of ball bearings, plastic bearings, and bronze bearings..

The change to claims 5 and 12 include that the bearings are selected from a group consisting of ... . The change also includes that the "and" is changed to an "or".

Claims 6 and 13 were modified as shown below to indicate that the third member is connected to only the second or outer member and does not recite the third member as a cover.

Claim 6 (currently amended) A wheel cover as recited in claim 1 that further includes a third ~~cover~~ member connected with a bearing to the first or second outer member.

Claim 13 (currently amended) A wheel cover as recited in claim 8 that further includes a third member connected with a bearing to the first or second member.

#### **Novelty (35 USC § 102)**

The Office considers claims 1, 7-8 and 14 rejected under 35 U.S.C. 102(b) for being anticipated by Whiteman (US 2,997,344). The applicant disagrees based upon the changes made to claims 1, 8.

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In each and every embodiment described by Whiteman both in text and in the figures, the member closest to "the inner hub 31 is freely rotatable relative to the outer hub 13" [Col 2 lines 28-29] The "outer hub cap 13 that is provided with a peripheral turned flange 14 provided with conventional latches 13' and which is suitably secured in any desired conventional manner to the peripheral rim of the vehicle wheel 11." [Col 1 lines 66-70]

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (MPEP § 2131)"

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Based upon the above analysis, Whiteman lacks disclosure as set forth in the claim. The structure of Whiteman is also different where it discloses the outer hub cap (13) col 1, lines 66-69 attaches to the vehicle rim (11) and that the inner spinning hub (31) col 2, lines 20-22 is located between the outer hub cap and the vehicle rim as shown in the cross sectional view, figure 2. In the pending application, the second or spinning member is located on the outside of the member that is attached to the vehicle rim. This is the opposite configuration patented and disclosed by Whiteman. Based upon this analysis and the lack of identification where in the specifications the elements are "arranged as required by the claim" the applicant believes that the application as amended is not anticipated under 35 USC § 102.

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The addition of the limitation requiring that "the entire outer facing surface of the outer member that is not secured to the vehicle rim is visible" (emphases added) further differentiates the application from Whiteman because the outer member that is not attached to the vehicle rim is visible. In the configuration disclosed by Whiteman the entire outer facing surface of the outer hub 13 is visible, and the outer hub 13 is secured to the vehicle wheel 11. Only portions of the inner spinning hub 31 are visible. This configuration is the opposite of the configuration disclosed in the pending application.

Based upon the claim limitations described, each and every limitation of the claims as required by MPEP § 2131 is not disclosed by Whiteman. Claims 7 and 14 are not obvious based upon the changes made to claims 1 and 8 by virtue of dependence on independent claims 1 and 8.

The Office considers claims 1, 5, 7-9 and 14 anticipated under 35 U.S.C. 102(e)(1) for being anticipated by Good (US 2004/0075332 A1).

A rejection under 102(e)(1) requires that:

"(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or"

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Good was filed in October 14, 2003 and the patent was issued/published on April 22, 2004. The pending application was filed September 26, 2003, based upon the first available patented / published date of Good and the filing date of the pending application, Good is not available as a reference under 35 USC §102(e)(1).

**Obviousness (35 USC § 103(a))**

The examiner has rejected Claims 2, 4-6, 9 11-13 under 35 U.S.C. 103(a) as being unpatentable over Whitemand (US 2,997,344) in view of Wallach (US 6,820,475). Wallach was first published in November 23, 2004. The pending application was filed September 26, 2003, based upon the first available patented / published date of Good and the filing date of the pending application, Wallach is not available as a reference under 35 USC §103.

The office considers claims 3 and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Whitman (US 2,997,344) in view of Miyanaga (US 3,367,722) patent. The Whitman patent discloses that the spinning member is located between the outer cover and the vehicle rim. The Miyanaga patent is a cover to prevent dirt or other contaminants from entering the stems used to fill the tires with air. The purpose and function of each of these patents is different

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the

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reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. (emphasis added)

While both patents are wheel covers, there is no teaching, suggestion or motivation in the identified prior art to combine the two patents as required under 103(a). The problem being solved by the Miyanaga patent is to cover the rim for protection, and the problem being solved by the Whitman patent is to expose the rim for visual appearance. These two patent have opposing problems they are trying to solve and therefore there is no teaching motivation or suggestion to combine them.

Claims 2, 4-6, 9 11-13 are also not obvious based upon the changes made to claims 1 and 8 by virtue of their dependence on independent claims 1 and 8.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,  
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